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EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 06/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759.353

Applicant(s)

CHALLET, JEAN PIERRE

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communications filed on 3/17/03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/16/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other _____ |

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Status of Application

Applicant's comments filed March 17, 2003 have been fully considered but are not found persuasive as to the issues set forth in this Office action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 9, lines 5-7, Applicant states disc florets "commonly are absent under standard growing conditions". The recitation "commonly are absent" is unclear as it is not understood whether the instant plant's flowers contain disc florets some of the time and do not contain them at other times or whether the instant plant produces some flowers containing disc florets and

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some flowers not containing disc florets or something else. It appears the instant plant may produce disc florets but that they are hidden beneath the ray florets. This recitation is also concerning regarding the stability of the instant plant. It appears the instant plant may be unstable and that there may be more than one plant being described. If either of the cases is true, applicant would be unable to obtain a U.S. Plant Patent under 35 U.S.C. 161 (MPEP 1600) for the instant plant/application. Either the instant plant produces flowers which contain disc florets or the instant plant does not produce flowers which contain disc florets.

B. As stated in the previous Office actions mailed December 17, 2002 and March 25, 2002, Applicant states the Androecium is present on ray florets. This is not understood and appears botanically incorrect as the androecium is typically found only on disc florets and the gynoecium is typically found on both ray and disc florets. This plant does not commonly have disc florets as set forth on page 9, lines 5-7. Correction and/or clarification is necessary.

C. As stated in the previous Office actions mailed December 17, 2002 and March 25, 2002, Applicant states the instant plant produces pollen. This is not understood and appears botanically incorrect as the instant plant does not commonly have disc florets (as stated on page 9, lines 5-7) and without disc florets, in which the androecium would be located, cannot produce pollen. Correction and/or clarification is necessary.

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The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Claim Rejection

The Claim remains rejected under 35 U.S.C. 102(b) as being clearly anticipated by Plant Breeder's Right application number 15135 (France) or the 1997 Catalog of Challet Herault Productions of Nuaille France in view of Applicant's admission that 'Chanoud' was "placed in the hands of the public in France during 1997" (Page 4 of response filed September 25, 2002), for the reasons stated in the previous action.

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Response to Arguments

Applicant's remarks filed March 17, 2003 have been fully considered but are not considered persuasive for the following reasons:

Applicant argues that "The continued rejection of the claim under 35 U.S.C. §102(b) over publications with respect to (a) French Breeders Rights Application No. 15135, and (b) the 1997 French Catalog would be inappropriate for the reasons set forth in detail in Applicant's submission of September 25, 2002. The Examiner respectfully disagrees with Applicant for the reasons set forth in detail in the previous Office action mailed December 17, 2002.

Applicant argues that "For a plant to enter the public domain one must look to the statutory language as it has existed and been interpreted for over seventy years. There must be public use or sale in the United States for a sufficient time prior the United States filing date in order to create a statutory bar. This has not occurred as indicated in Applicant's submission of September 25, 2002. Any printed publication concerning the 'Chanoud' variety is non-enabling.". The Examiner respectfully disagrees with Applicant. As stated in the previous Office action, mailed December 17, 2002, specifically page 9, "Prior public use or sale are the avenues by which a plant enters the public domain (*LeGrice*, page 372.). Further, the "public use or sale" does not have to take place in the United States to rise to the level of a statutory bar. This argument is not persuasive for two reasons: (1) This issue was not present in *LeGrice*, and (2) This issue is not

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present in the instant case. The rejection is based on a publication, not prior use or sale. As stated in the previous Office action, mailed December 17, 2002, specifically pages 9 and 10, "The clear wording of 35 USC 102(b) is "A person shall be entitled to a patent unless- ...(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States..." ". "There is no requirement/restriction of the bar under 35 USC 102(b) to printed publications in this country. The second clause of 35 USC 102(b) barring public sale or use in this country is not relevant because the rejection under 35 USC 102(b) over the foreign breeder right certificate or French catalog, as enabled by a sale to the public in a foreign country over one year prior to the date of domestic filing, would not be over public use or sale, but over a printed publication." "In *Pentech International Inc. v. Hayduchok*, 18 USPQ2d 1337, it stated that the "on-sale-bar" must be "in public use or on sale in this country, more than one year prior to the date on the application for patent in the United States.". *Pentech v. Hayduchok* later states "a foreign use or sale, **without a printed publication** or patent as described in 102(a), will not undermine the validity of a patent issued in the United States" (page 1343). For the instant application, the plant was described in the Plant Breeder's Right application and French catalog which, when combined with commercial availability in a foreign country, would have enabled one skilled in the art to reproduce the claimed invention.".

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Applicant argues "The Examiner has cited no authority for the assertion that the availability an invention outside the United States combined with a non-enabling publication has ever been used to create a statutory bar other than the *Ex parte Thomson* decision." The Examiner respectfully disagrees, the Examiner has cited case law which supports the instant rejection.

Applicant argues "As specified at 35 U.S.C. §161, Plant Patents and Patents for other inventions should be subject to the same statutory provisions "except as otherwise provided." Title 35 provides no exception capable of supporting a different rule for Plant Patents. For the reasons indicated in Applicant's submission of September 25, 2002, the controlling authority is the *In re LeGrice* decision that was rendered by the Court of Customs and Patent Appeals.". The Examiner respectfully disagrees. *In re LeGrice* as well as 35 USC 161 and 37 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents also are applicable to patents for plants except for the one exception set forth in 35 USC 162. As a result, the standard for anticipation in a plant patent is the same as the standard for anticipation in a utility patent.

Applicant argues "there is no sound reason for Patent Office personnel to put forth at this time a different interpretation of the statute from that which has been consistently followed for decades. Such new interpretation is urged to be inappropriate as well as grossly unfair to Applicant.". After careful consideration of this argument, the Examiner declines to comment on this business practice as the issue is not germane to the current rejection.

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Applicant argues "Plant publications are to be disregarded when making a patentability analysis with respect to a new plant variety unless they can be combined with the existing scientific "store of knowledge in the fields of plant heredity and plant eugenics which one skilled in the art will be presumed to possess" so as to enable another to produce the plant. The mere possibility to seed an invention in a foreign country where it is not prior art and to bring it to the United States has never been an impediment to patent protection in the absence of a showing that the invention was on sale or in public use in the United States more than one year before filing date.". The Examiner respectfully disagrees. The PBR publication or French Catalog when considered in combination with the knowledge of one skilled in the art, i.e., the availability of the plant in the public domain as evidenced by sale of the claimed plant more than one year prior to application for patent, places the plant in the public domain, and therefore is enabled since one skilled in the art would have been able to reproduce that exact same plant through asexual means. It is noted that Applicant has not provided any evidence that one skilled in the art would know how to propagate a Chrysanthemum. *LeGrice* ruled that a publication alone was not enough to put a plant in the public domain. The fact scenario of this rejection does not parallel the facts in the *LeGrice* case because the rejection here is not based on a publication alone. Indeed, *LeGrice* makes it very clear that "Prior public use and sale of a plant are the avenues by which a plant enters the public domain." The PBR publication or French Catalog, together with public availability of the plant, would have allowed a skilled artisan to take the teachings of either the

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cited PBR or French Catalog and combine them with his own knowledge of the art to be in possession of the invention.

Final

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.